IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Re: Appeal to the Board of Patent Appeals and Interferences

In re Application of:)	
Mark G. Meyer et. al.)	Examiner: Robert E. Pezzuto
)	
Serial No: 10/612,307)	Art Unit: 3714
)	
Filed: July 2, 2003)	Confirmation No.: 4054
)	
Title: Lottery Game Method)	Deposit Acct. No: 04-1403
)	
_____)	Client ID: 22827

1. ☐   **NOTICE OF APPEAL**: Pursuant to 37 CFR 41.31, Applicant hereby appeals to the Board of Appeals from the decision dated _____ of the Examiner twice/finally rejecting claims _____.

2. ☐   **BRIEF** on appeal in this application pursuant to 37 CFR 41.37 is transmitted herewith (1 copy).

3. ☐   An **ORAL HEARING** is respectfully requested under 37 CFR 41.47 (due within two months after Examiner's Answer).

4. ☒   Reply Brief under 37 CFR 41.41(b) is transmitted herewith (1 copy).

5. ☐   "Small entity" verified statement filed: [ ] herewith [ ] previously.

6.   **FEE CALCULATION:**   **Fees**

        If box 1 above is X'd enter $ 540.00 $ _____ 0.00

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PETITION is hereby made to extend the <u>original</u> due date of _____, hereby made for an extension to cover the date this response is filed for which the requisite fee is enclosed (1 month $130; 2 months $490; 3 months $1,110; 4 months $1,730, 5 months $2,350 $ _____ 0.00

                                    SUBTOTAL: $ _____ 0.00

<u>Less</u> any previous extension fee <u>paid</u> since above original due date.   - $ _____ 0.00

<u>Less</u> any previous fee paid for prior Notice of Appeal since Board did not render a decision on the merits. MPEP § 1204.01   - $ _____ 0.00

<u>Less</u> any previous fee paid for submitting Brief on prior Appeal since Board did not render a decision on the merits. MPEP § 1204.01   - $ _____ 0.00

                                    SUBTOTAL: $ _____ 0.00

If "small entity" verified statement filed ☐ previously,
☐ herewith, enter one-half (½) of subtotal and <u>subtract</u>　-　$ ___ 0.00

TOTAL FEE ENCLOSED:　$ ___ 0.00

☐　Fee enclosed.

☐　Charge fee to our Deposit Account/Order Nos. in the heading hereof (for which purpose one <u>additional</u> copy of this sheet is attached)

☒　Charge to credit card (attach Credit Card Payment Form – PTO 2038)

☐　Fee <u>NOT</u> required since paid in prior appeal in which the Board of Appeals did <u>not</u> render a decision on the merits.

The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any fees in addition to the fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (<u>deficiency only</u>) now or hereafter relative to this application and the resulting official document under Rule 20, or credit any overpayment, to our Account No. shown in the heading hereof. This statement <u>does not</u> <u>authorize</u> charge of the <u>issue fee</u> in this case.

DORITY & MANNING ATTORNEYS AT LAW, P.A.

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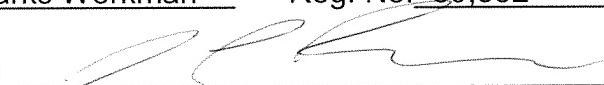
I hereby certify that this correspondence and all attachments and any fee(s) are being electronically transmitted via the internet to the U.S. Patent and Trademark Office using the Electronic Patent Filing System on __ March 9, 2009 ____.

Diane L. Petrice _____
(Typed or printed name of person transmitting documents)

_____
(Signature of person transmitting documents)

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REPLY BRIEF TO SECOND EXAMINER'S ANSWER

Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant filed a Notice of Appeal in the present application on August 30, 2007.

An Appeal Brief was timely filed on October 31, 2007, appealing the final rejection of

claims 1-42. The Examiner filed an Examiner's Answer in response to the Appeal Brief

on May 1, 2008. Applicant submitted a Reply Brief on July 1, 2008. The Examiner

acknowledged receipt of the Reply Brief on July 16, 2008, indicating that the present

appeal was ready for decision by the Board of Patent Appeals and Interferences.

On January 8, 2009, the Examiner filed a Second Examiner's Answer providing a

new ground of rejection of claims 1-29 and 35-41 under 35 U.S.C. § 101.[1] Pending

claims 30-34 and 42 are not subject to the new grounds of rejection.

The Applicants respectfully submit the enclosed Reply Brief in accordance with

37 C.F.R. § 41.41.

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[1] The Examiner mailed two additional Answers in this case, one on December 3, 2008
and one on January 8, 2009. The applicant treats the most recent Examiner's Answer
mailed on January 8, 2009 as the Second Examiner's Answer.

I.   **REAL PARTY IN INTEREST**

The assignee Scientific Games International Inc. is the real party in interest.

II.   **RELATED APPEALS AND INTERFERENCES**

See Applicants' Appeal Brief

III.   **STATUS OF CLAIMS**

Claims 1-42 are pending in the present application. Claims 1-42 stand rejected. In the Examiner's most recent Answer, the Examiner issued a new ground of rejection of claims 1-29 and 35-41 under 35 U.S.C. § 101.

According to M.P.E.P. § 1207.03 II, it is questionable whether the Examiner has the authority to enter a new ground of rejection after the filing of Applicant's Reply Brief. See M.P.E.P. § 1207.03 II. However, to advance the pending appeal in this case, Applicant hereby withdraws claims 1-29 and 35-41 from appeal and authorizes the Examiner to cancel claims 1-29 and 35-41 from the pending application. The Applicant in no way acquiesces to the propriety of the new grounds for rejection and the Applicant reserves the right to pursue withdrawn claims 1-29 and 35-41 in a later filed divisional application.

Claims 30-34 and 42 are not subject to the new grounds of rejection and have not been withdrawn from appeal by the applicant. The appeal continues as to these remaining claims. Applicant respectfully requests that the application be forwarded to the Board for decision on the merits as to claims 30-34 and 42.

IV.   **STATUS OF AMENDMENTS**

See Applicants' Appeal Brief

V.   SUMMARY OF CLAIMED SUBJECT MATER

See Applicants' Appeal Brief

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 30-34 and 42 remain pending in the present appeal. The grounds of

rejection to be review on appeal include:

A.   Whether claims 30-34 are patentable under 35 U.S.C. § 103(a) over www.powerball.com (Powerball) in view of U.S. Patent No. 6,497,408 to Walker (Walker '408).

B.   Whether claim 42 is patentable under 35 U.S.C. § 103(a) over Powerball in view of Walker '408

VII.   ARGUMENT

A.   Claims 30-34 are Patentable under 35 U.S.C. § 103(a) over Powerball in view of Walker

The applicant's arguments with respect to the patentability of claims 30-34 over

Powerball and Walker have been set forth in detail in applicant's Appeal Brief filed

October 31, 2007 and Reply Brief on July 1, 2008. These arguments are repeated here

for convenience of the Board.

Applicant respectfully traverses the rejection of claims 30-34 under 35 U.S.C.

103(a) over Powerball in view of Walker '408 for at least the reason that Powerball does

not disclose or teach each and every element of independent claim 30, and Walker '408

fails to cure such deficiencies. Specifically, independent claim 30 recites a gaming

apparatus that includes a controller configured for receiving player symbol data via the

network indicative of a plurality of sets of player symbols associated with a player for a

single play of a game. The controller is further configured to determine a value payout

based on respective numbers of winning symbols in respective sets of player symbols.

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The value payout for winning a plurality of sets on a single play <u>is different</u> than the sum of the individual payouts for winning each set individually.

Powerball teaches a value payout for winning a plurality of player sets on a single play that is <u>equal to</u> the sum of individual value payouts for winning each player set individually. To illustrate, consider the example in which a player purchases two entries in a game of Powerball consisting of Entry A and Entry B. Suppose Entry A consists of one match and the occurrence of a powerball. The payout for winning Entry A individually consists of $4 (*see* Powerball Table 1). Suppose Entry B consists of two matches and the occurrence of a powerball. The payout for winning Entry B consists of $7 (*see* Powerball Table 1). The total payout for winning both Entry A and Entry B (the plurality of player sets) in a single game would be $11, which <u>is equal to</u> the sum of winning Entry A and Entry B individually. Thus, Powerball fails to teach a gaming apparatus configured to determine a value payout for winning a plurality of player sets on a single play that <u>is different</u> than the sum of individual payouts for winning each set individually.

Walker '408 fails to correct the deficiencies of Powerball. Walker '408 teaches a system and method for conducting and playing a separate, supplemental lottery game that allows the player to qualify for an award if the player <u>fails to win</u> in the primary lottery game or if the player <u>fails to reach a certain threshold of winning</u> in the primary lottery game (Walker '408, col. 3, l. 5-8). Walker '408 merely provides a backup lottery game for receiving a value payout that arises when all of the sets played are losers or below a threshold of winning. In that situation, the player may receive another value payout from a <u>completely separate</u> meta-game. This value payout is not based on

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winning a plurality of sets <u>on a single play</u>, but rather on losing a plurality of sets on a single play in a primary lottery game, and qualifying for a different value payout on a second play in a separate, supplemental meta-game.

Walker '408 teaches situations in which the value payout <u>specifically for the separate meta-game</u> is different than the sum of a plurality of individual payouts for winning each set individually <u>in the primary lottery game</u> (*see* Walker '408, col.9, l. 39-43; Fig. 3). However, Walker '408 fails to disclose a value payout for winning a plurality of sets <u>on a single play</u> that is different than the sum of a plurality of individual payouts for winning each set individually. As discussed above, Walker '408 discloses two distinct lottery games. Specifically, embodiments of Walker '408 "provide a system and method by which players participating in a primary lottery drawing <u>may elect to participate in a second, or derivative lottery drawing</u>." (Walker 408, col. 2, l. 66 to col. 3. l. 2). In fact, to be eligible to play in the separate, supplement meta-game, a player must register separately for the meta-game. (Walker '408, col. 3, l. 9-13). According to Walker '408, a player may win a value payout <u>in the separate meta-game</u> that is different than the value payout <u>in the primary lottery game</u>. However, to win this different value payout, a player must participate a second time in the second, supplemental meta-game. Thus, Walker '408 fails to teach a value payout for winning a plurality of sets <u>on a single play</u> that is different than the sum of a plurality of individual payouts for winning each set individually. For these reasons, Applicants respectfully assert that the combination of Powerball and Walker '408 fails to disclose each limitation recited in claim 30.

Moreover, Applicants respectfully assert that Walker '408 <u>teaches away</u> from a value payout for <u>winning a plurality of player sets on a single play</u> that is different than the sum of a plurality of individual payouts for winning each set individually. As discussed above, Walker '408 teaches a value payout in a separate meta-game that is based on <u>losing</u> or <u>failing to reach a certain threshold of winning</u> a plurality of sets in the primary lottery game. In fact, the odds of the plurality of player sets qualifying for a value payout in the separate meta-game are inversely proportional to the odds of the plurality of player sets <u>winning</u> an award in the primary lottery game (*see* Walker '408, col. 8, l. 35-41). A prior art reference that discloses a game that requires <u>losing</u> multiple player sets in a primary lottery game in order to win a value payout in a separate, supplemental meta-game expressly <u>teaches away</u> from a gaming apparatus that is configured for determining a value payout for <u>winning</u> a plurality of player sets <u>on a single play</u> that is different from the sum of value payouts for <u>winning</u> each player set individually.

Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. 103(a) rejection of independent claim 30 based on the combination of Powerball and Walker '408. Inasmuch as claims 31-34 depend from independent claim 30 and include further limitations not recited in claim 30, Applicants respectfully assert that claims 31-34 are similarly patentable over the combination of Powerball and Walker '408.

B.   Claim 42 is Patentable under 35 U.S.C. § 103(a) over Powerball in view of Walker

The Applicant's arguments with respect to the patentability of claim 42 over Powerball and Walker have been set forth in detail in applicant's Appeal Brief filed

October 31, 2007 and Reply Brief on July 1, 2008. These arguments are repeated here for convenience of the Board.

Applicant respectfully traverses the rejection of claim 42 under 35 U.S.C. 103(a) over Powerball in view of Walker '408 for at least the reason that Powerball does not disclose or teach each and every element of independent claim 42, and Walker '408 fails to cure such deficiencies. Specifically, independent claim 42 recites a gaming apparatus that includes a controller configured to determine a plurality of sets of player symbols associated with a player for a single play of a game. The controller is further configured to determine a value payout based on respective numbers of winning symbols in respective sets of player symbols. The value payout for winning a plurality of sets on a single play is different than the sum of the individual payouts for winning each set individually.

Powerball teaches a value payout for winning a plurality of player sets on a single play that is equal to the sum of individual value payouts for winning each player set individually. To illustrate, consider the example in which a player purchases two entries in a game of Powerball consisting of Entry A and Entry B. Suppose Entry A consists of one match and the occurrence of a powerball. The payout for winning Entry A individually consists of $4 (see Powerball Table 1). Suppose Entry B consists of two matches and the occurrence of a powerball. The payout for winning Entry B consists of $7 (see Powerball Table 1). The total payout for winning both Entry A and Entry B (the plurality of player sets) in a single game would be $11, which is equal to the sum of winning Entry A and Entry B individually. Thus, Powerball fails to teach a gaming apparatus configured to determine a value payout for winning a plurality of player sets

on a single play that <u>is different</u> than the sum of individual payouts for winning each set individually.

Walker '408 fails to correct the deficiencies of Powerball. Walker '408 teaches a system and method for conducting and playing a separate, supplemental lottery game that allows the player to qualify for an award if the player <u>fails to win</u> in the primary lottery game or if the player <u>fails to reach a certain threshold of winning</u> in the primary lottery game (Walker '408, col. 3, l. 5-8). Walker '408 merely provides a backup lottery game for receiving a value payout that arises when all of the sets played are losers or below a threshold of winning. In that situation, the player may receive another value payout from a <u>completely separate</u> meta-game. This value payout is not based on winning a plurality of sets <u>on a single play</u>, but rather on losing a plurality of sets on a single play in a primary lottery game, and qualifying for a different value payout on a second play in a separate, supplemental meta-game.

Walker '408 teaches situations in which the value payout <u>specifically for the separate meta-game</u> is different than the sum of a plurality of individual payouts for winning each set individually <u>in the primary lottery game</u> (*see* Walker '408, col.9, l. 39-43; Fig. 3). However, Walker '408 fails to disclose a value payout for winning a plurality of sets <u>on a single play</u> that is different than the sum of a plurality of individual payouts for winning each set individually. As discussed above, Walker '408 discloses two distinct lottery games. Specifically, embodiments of Walker '408 "provide a system and method by which players participating in a primary lottery drawing <u>may elect to participate in a second, or derivative lottery drawing</u>." (Walker 408, col. 2, l. 66 to col. 3. l. 2). In fact, to be eligible to play in the separate, supplement meta-game, a player

must register separately for the meta-game (Walker '408, col. 3, l. 9-13). According to Walker '408, a player may win a value payout in the separate meta-game that is different than the value payout in the primary lottery game. However, to win this different value payout, a player must participate a second time in the second, supplemental meta-game. Thus, Walker '408 fails to teach a value payout for winning a plurality of sets on a single play that is different than the sum of a plurality of individual payouts for winning each set individually. For these reasons, Applicants respectfully assert that the combination of Powerball and Walker '408 fails to disclose each limitation recited in claim 42.

Moreover, Applicant respectfully asserts that Walker '408 teaches away from a value payout for winning a plurality of player sets on a single play that is different than the sum of a plurality of individual payouts for winning each set individually. As discussed above, Walker '408 teaches a value payout in a separate meta-game that is based on losing or failing to reach a certain threshold of winning a plurality of sets in the primary lottery game. In fact, the odds of the plurality of player sets qualifying for a value payout in the separate meta-game are inversely proportional to the odds of the plurality of player sets winning an award in the primary lottery game (see Walker '408, col. 8, l. 35-41). A prior art reference that discloses a game that requires losing multiple player sets in a primary lottery game in order to win a value payout in a separate, supplemental meta-game expressly teaches away from a gaming apparatus that is configured for determining a value payout for winning a plurality of player sets on a single play that is different from the sum of value payouts for winning each player set individually.

Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. 103(a) rejection of independent claim 42 based on the combination of Powerball and Walker '408.

C.   Reply to Examiner's Answer

In the Examiner's Answer, the Examiner alleges that multidimensional lookup table of Powerball teaches that the value of some payouts are different from the sum of the plurality of payouts. (Ex. Ans. at 10). The Examiner seems to confuse "a plurality of player symbols" with "a plurality of sets of player symbols."

As discussed in detail above, Powerball teaches a value payout for winning a plurality of player sets on a single play that is equal to the sum of individual value payouts for winning each player set individually. To illustrate, consider the example in which a player purchases two entries in a game of Powerball consisting of Entry A and Entry B. Suppose Entry A consists of one match and the occurrence of a powerball. The payout for winning Entry A individually consists of $4 (*see* Powerball Table 1). Suppose Entry B consists of two matches and the occurrence of a powerball. The payout for winning Entry B consists of $7 (*see* Powerball Table 1). The total payout for winning both Entry A and Entry B (the plurality of player sets) in a single game would be $11, which is equal to the sum of winning Entry A and Entry B individually. Thus, Powerball fails to teach a gaming apparatus configured to determine a value payout for winning a plurality of player sets on a single play that is different than the sum of individual payouts for winning each set individually.

In the Examiner's Answer, the Examiner also states that "Walker discloses determining a value payout for winning a plurality of entries on **a single play.**" (Ex. Ans.

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at 12) (emphasis in original). In particular, the Examiner states that the meta-game of

Walker "can be interpreted as a game within a game or part of an overall game." (Ex.

Ans. at 13). The Examiner further argues "the meta-game/enhanced payout is part of

the lottery game itself and the lottery game in its entirety is the single game." (Ex. Ans.

at 13). Applicants respectfully disagree.

Contrary to the Examiner's assertions, the meta-game of Walker is a completely

separate supplemental lottery game that is different from the primary lottery game. In

particular, the Summary of the Invention section of Walker discloses:

> Embodiments of the present invention provide a system and
> method by which players participating in a primary lottery drawing
> may elect to participate in a second or derivative lottery drawing
> (hereinafter a "meta-game").

(Walker, col. 2 line 66 to col. 3, line 8). To be eligible to play in the separate,

supplemental meta-game, a player must register separately for the meta-game (see

Walker, col. 3, l. 9-13). Simply because a player may register for the second,

supplemental meta-game in the same transaction as the primary lottery game does not

transform the meta-game into a game within a game or part of an overall game.

Indeed, Walker '408 consistently refers to the meta-game as a secondary game. For

instance, Walker teaches as follows:

> Generally, embodiments of the present invention allow lottery
> players to register a group of one or more primary lottery drawing entries
> in a secondary game (the "meta game.").

(Walker, col. 4, lines 18-21).

Finally, the Examiner alleges that "every aspect of the meta-game is off a single

play of the primary lottery." (Ex. Ans. at 13). Figure 7 of Walker reproduced below,

however, dispels this argument.
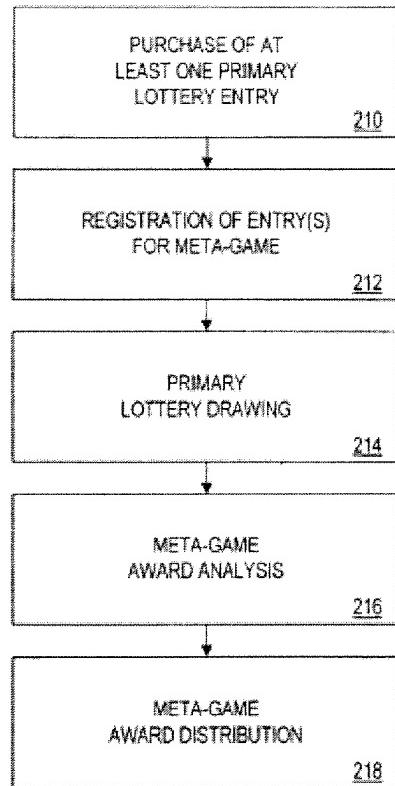
As illustrated, the primary lottery drawing 214 is clearly separate from the meta-game award analysis 216. Walker '408 even provides:

> After the primary lottery drawing has been held (step 214), the controller 20 performs a meta-game award analysis (step 216) to determine which registered groups have won meta-game awards. Alternatively, this analysis may be performed on an individual group basis when a player attempts to redeem an award or when a player contacts the controller 20 to verify if a group registered by a player has qualified for a meta-game award.

(Walker '408, col. 14, lines 49-56). The meta-game award of Walker '408 is not off the primary lottery drawing, but rather is the result of an independent and separate meta-game award analysis performed after the primary lottery drawing has been held. This meta-game award analysis includes determining whether the player decided to play a second time in a second supplemental lottery game. (See step 354, "Access

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Registration Database and Identify Associated Meta-Games."). Thus, to win an award in the meta-game of Walker '408, a player must play at least twice, once in the primary lottery drawing and once in the separate meta-game.

In contrast, claims 30-34 and 42 require player symbol data indicative of a plurality of sets of player symbols associated with a player <u>for a single play of a game</u>. The controller configured to determine a value payout based on respective numbers of winning symbols in respective sets of player symbols, wherein for at least some value payouts the value payout for winning a plurality of sets <u>on the single play</u> is different than a sum of a plurality of individual value payouts for winning each set individually.

For at least the foregoing reason, the combination of Walker '408 with Powerball fails to teach a value payout for winning a plurality of sets <u>on a single play</u> that is different than the sum of a plurality of individual payouts for winning each set individually. In this regard, Applicants respectfully assert that the combination of Powerball and Walker '408 fails to disclose each limitation recited in the claims.

D.   Response to New Grounds of Rejection

In the new Examiner's Answer filed on January 8, 2009, the Examiner raises a new ground of rejection, rejecting claim 1-29 and 35-41 under 35 U.S.C. § 101. Claims 1-29 and 35-41 have been withdrawn from appeal and are no longer pending before the Board. Thus, the Examiner's new grounds of rejection are moot.

VIII.　CLAIMS APPENDIX A

See attached listing of pending claims involved in this appeal.

IX.　EVIDENCE APPENDIX B

Applicants do not rely on any evidence submitted pursuant to 37 CFR 1.130,

1.131, or 1.132 or any other evidence entered by the examiner in this appeal.

X.　RELATED PROCEEDINGS APPENDIX C

Applicants are not aware of any decision rendered by a court of the Board in any

related appeals or interferences.

For at least the reasons discussed above and the reasons set forth in Applicants'

Appeal Brief, the Applicants respectfully submit that the final rejection of claims 30-34

and 42 should be reversed and that the application be remanded to the Examiner for

allowance.

Respectfully submitted,
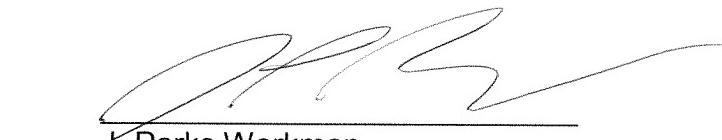
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APPENDIX A – PENDING CLAIMS

The following is a listing of the claims involved in this appeal:

30.   A gaming server, comprising:

a controller operatively coupled to a network, the controller comprising a microprocessor and a memory operatively coupled to the microprocessor, the controller configured to receive player symbol data via the network, the player symbol data indicative of a plurality of sets of player symbols associated with a player for a single play of a game, wherein each player symbol is selected from a plurality of possible symbols;

the controller configured to receive, via the network, an indication that the player has submitted a wager for a plurality of sets of player symbols in a single play;

the controller configured to receive winning symbol data indicative of a set of winning symbols from the plurality of possible symbols;

the controller configured to determine a value payout based on respective numbers of winning symbols in respective sets of player symbols, wherein for at least some value payouts the value payout for winning a plurality of sets on the single play is different than a sum of a plurality of individual value payouts for winning each set individually, each individual payout based on the respective number of winning symbols in the corresponding set of player symbols; and

the controller configured to transmit, via the network, player payout data indicative of the value payout.

31.   A gaming server as defined in claim 30, wherein the controller is configured to receive the player selected symbol data from a lottery terminal operatively coupled to the network.

32.   A gaming server as defined in claim 30, wherein the controller is configured to receive the player symbol data from a personal computing device operatively coupled to the network.

33.   A gaming server as defined in claim 30, wherein the controller is configured to receive the indication that the player has submitted the wager from a lottery terminal operatively coupled to the network.

34.   A gaming server as defined in claim 30, wherein the controller is configured to receive the indication that the player has submitted the wager from a personal computing device operatively coupled to the network.

42.   A gaming apparatus, comprising:

a value input device;

a controller operatively coupled to a network and to the value input device, the controller comprising a microprocessor and a memory operatively coupled to the microprocessor,

the controller configured to determine a wager for a plurality of sets of player symbols in a single play of a game has been received from a player via the value input device;

the controller configured to determine a plurality of sets of player symbols associated with the player for a single play, wherein each player symbol is selected from a plurality of possible symbols;

the controller configured to determine a value payout based on respective numbers of winning symbols in respective sets of player symbols, wherein the winning symbols are from a set of winning symbols from the plurality of possible symbols, wherein for at least some value payouts the value payout for winning a plurality of sets on the single play is different than a sum of a plurality of individual value payouts for winning each set individually, each individual payout based on the respective number of winning symbols in the corresponding set of player symbols; and

the controller configured to provide the value payout, if any, to the player.

APPENDIX B – EVIDENCE

None.

APPENDIX C - RELATED PROCEEDINGS

None.